



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,671	03/26/2001	Kazunori Matsumoto	43890-504	5732

7590

05/21/2002

MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

MARC, MCDIEUNEL

ART UNIT

PAPER NUMBER

3661

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/816,671	Applicant(s) MATSUMOTO, KAZUNORI	
	Examiner McDieunel Marc	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9-13 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) 2-8 and 14-18 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 20) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to a letter for patent filed on March 26th, 2001, in which claims 1-13 are presented for examination. Claims 1-13 are pending in the letter.
2. Preliminary amendment filed on 03/26/2001 has been entered.

Priority

3. Acknowledgment is made of the claim for priority under *35 U.S.C. 119 (a)-(d)*, which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statements filed on 03/26/2001 complies with the provisions of MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits. A signed copy of the PTO 1449 form is attached.

Specification

5. It is noted that the present application does not contain line numbers in the specification and the claims, however, it is suggested that every fifth line of the specification be numbered, with each page starting with line 1, and the page numbering being continuous through the claims

and the abstract. For ease of reference by both the examiner and applicant it is recommended that this convention be adopted for future correspondence.

Claim Objections

6. Claims 1 and 9-11 are objected to because of the following informalities:

Claim 1, line 3 the word "the" should be replaced by -- an --;

Claim 9, line 18, pronoun should not be used rather than being referred to by "it" should be set forth. Appropriate correction is required.

Claim 10, line 9, pronoun should not be used rather than being referred to by "it" should be set forth. Appropriate correction is required.

Claim 11, line 6, pronoun should not be used rather than being referred to by "it" should be set forth.

Regarding claims 9-11, the use of the word "it" in the claim language is not clearly defined what's being referred to. Applicant is suggested to change "it" to -- said manipulator --, provided that's what "it" is referred to in the claims. Appropriate correction are required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Grob *et al.*, (U.S. Pat. No. 6,356,806 B1).

Grob *et al.* teaches an industrial robot, comprising:

a robot (see Fig. 1, element 2), please note that element 2 being a KUKA robot body;
a manipulator to control the operation (see Fig. 1, element 12 and col. 3, line 32), please note that “the robot control card 12 controls the robot 2”, and please bear in mind that element 12 works in collaboration with a standard PC computer as taught by Grob *et al.* as to the limitation of “said robot body” (see Fig. 1, element 2);

a control device (see Fig. 1, element 11) to control said manipulator (see Fig. 1, element 11);

a first path disposed between said manipulator and said control device (see Fig. 1, elements 11, and 12), please note that the arrow being considered as the path between the manipulator and the control device; and

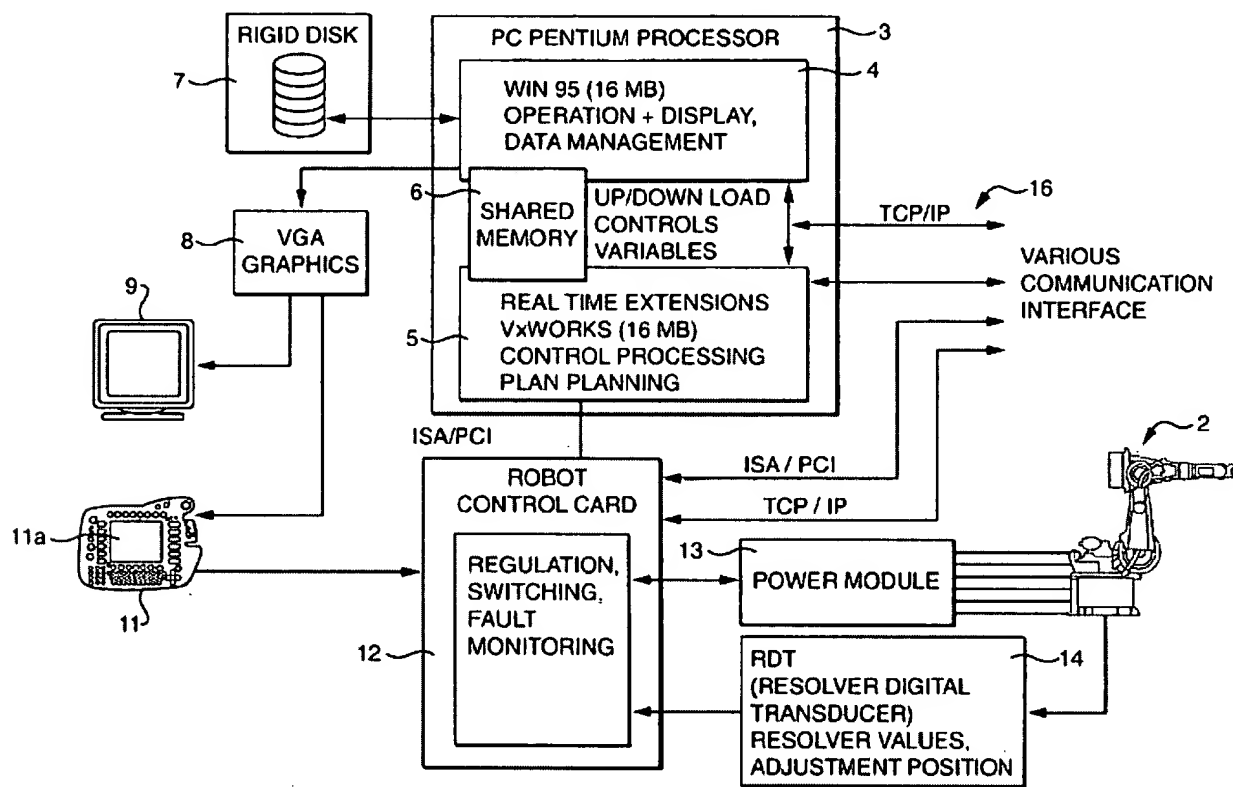


FIG. 1

a second path disposed between a commercial power source (see Fig. 1, element 13) and said manipulator (see Fig. 1, elements 13 and 12), please note that the “power module” of Grob *et al.* being considered as a commercial one, since Grob *et al.* discloses a “battery” and “DC voltage using a battery/accumulator” (see col. 4, lines 14 and 67) and the arrow that connects

between elements 13 and 12 of figure 1 being taken for the second path (see Fig. 1, elements 13 and 12).

Allowable Subject Matter

9. Claims 9-13 are allowed over prior art, but are objected to as set forth in paragraph 6.

10. The following is a statement of reasons for the indication of allowable subject matter:

While (U.S. Pat. No. 5,751,918 issued to Shimogawa *et al.* and U.S. Pat. No. 6,356,806 B1, for example) teach a robot that includes a robot body to which a procedure of a task is teachable; and a robot with PC control being provided. The prior art of record fail to teach or fairly suggested a method of operating an industrial robot, including the step of freely moving said robot body without being controlled by said manipulator, applying a voltage from said commercial power source to said manipulator when the manipulator is unable to be controlled by said first path in combination with the other elements of the claimed invention.

11. Claims 2-8 and 14-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fail to teach or fairly suggest according to claim 1, an industrial robot wherein a voltage supplied from said commercial power source in said second path is applied to said manipulator, and then said robot body becomes freely movable without being controlled by said manipulator as cited in claim 2. With respect to claim 3, an industrial robot wherein said manipulator includes a motor to drive said robot body, a brake to brake the motor, and said motor has a function to drive said manipulator, and said brake has a function to brake said motor. With respect to claim 5, an industrial robot having a voltage transformer disposed between said commercial power source and said manipulator in said second path, wherein said voltage transformer serves to transform the voltage supplied from said commercial power source to a voltage for releasing said brake.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

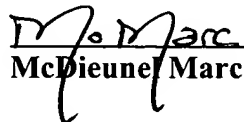
*** The prior arts cited in PTO-Form 892 with the exclusion of U.S. Pat. No. 5,751,918 issued to Shimogawa *et al.* and U.S. Pat. No. 6,356,806 B1) disclose pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to McDieunel Marc whose telephone number is (703) 305-4478.

The examiner can normally be reached on 6:30-5:00 Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


McDieunel Marc

May 16, 2002

MM/